

REMARKS/ARGUMENTS

Applicants acknowledge receipt of the Office Action dated March 1, 2003, in the parent application. In that Office Action, the Examiner: 1) objected to claims 8 and 23 for various informalities; 2) rejected claims 1 and 2 as allegedly anticipated by *Staples* (U.S. Patent No. 5,799,036); 3) rejected claim 3 as allegedly unpatentable over *Staples*; 4) rejected claims 4-9, 11, 14 and 23 as allegedly unpatentable over *Staples* in view of *Botkin et al.* (U.S. Patent No. 6,161,161; 5) indicated allowance of claims 15-22; and 6) objected to claims 10, 12 and 13 as being dependent upon rejected base claims.

Claims 1-23 were originally present in the parent application. With this Preliminary Amendment, Applicants cancel claims 10, 12, 13 and 15-22 in favor of those same claims in the parent case. Further, Applicants have amended claims 8 and 23 to correct the informalities. Applicants have further amended claims 1, 4 and 23. Claims 1-9, 11, 14, and 23 remain pending in the application.

I. AMENDMENTS TO THE SPECIFICATION

With the Preliminary Amendment Applicants present amendments to the specification in several locations. The amendments to the main body of the specification are to correct typographical errors noted by the Examiner in the parent case. Further, Applicants amend the Abstract to make the abstract more closely track claim 1. No new matter is introduced by these amendments.

II. REJECTIONS UNDER 35 USC § 102

The standard for a rejection under 35 USC § 102 is anticipation. "To anticipate a claim, the reference must teach every element of the claim." MPEP 2131. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Applicants respectfully traverse the anticipation rejections of amended claims 1-2 in view of *Staples*. Claim 1 as amended recites in part that the bridge logic and the first peripheral device are both associated with a first address line. *Staples* does not appear to teach or fairly suggest these features of amended claim 1. Claim 2 depends from claim 1 and are likewise believed allowable over *Staples*.

III. REJECTIONS UNDER 35 USC § 103

The standard for an obviousness rejection is a *prima facie* case. See MPEP 2142.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

MPEP 2142 (emphasis added).

Applicants respectfully traverse the obviousness rejection of amended claim 3 in view of *Staples*. Claim 1 as amended recites in part that the bridge logic and the first peripheral device are both associated with a first address line. *Staples* does not appear to teach or fairly suggest these features of amended claim 1. Claim 3 depends from claim 1 and is believed allowable over *Staples*.

Applicants respectfully traverse all obviousness rejections relying on the combination of *Staples* and *Botkin*. There is no motivation in the art to suggest combining *Staples* and *Botkin*. Applicants believe that Applicants' application provides the only suggestion for routing a first address line associated with the bridge logic and the first peripheral device to a second address line.

Botkin discloses a system and method for coupling a local bus to a PCI bus. *Botkin* is directed to "integration of a PCI device with the system that couples the local bus to the PCI bus. This allows a SAR design more suited to ADSL needs." [col. 2, lines 28-30].

Staples discloses a computer system which provides analog audio communication between a PC Card and the computer's sound system. *Staples* is directed to routing PC Card modem signals to the computer's sound system

using the digital SPKR pin and routing the computer system's audio to the PC Card modem using an RFU pin. [*Staples* Abstract].

Botkin is not directed to the problem of *Staples*. *Staples* is not directed to the problem of *Botkin*. There is no teaching in the art to suggest combining *Botkin* with *Staples*. Applicants respectfully request that the rejections combining *Botkin* and *Staples* be withdrawn.

IV. CONCLUSION

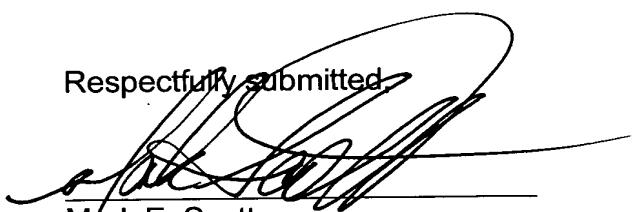
Applicants respectfully request reconsideration and allowance of the pending claims. If the Examiner feels that a telephone conference would expedite the resolution of this case, he is respectfully requested to contact the undersigned.

In the course of the foregoing discussions, Applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the prior art which have yet to be raised, but which may be raised in the future.

If any fees or time extensions are inadvertently omitted or if any fees have been overpaid, please appropriately charge or credit those fees to Hewlett-Packard Company Deposit Account Number 08-2025 and enter any time extension(s) necessary to prevent this case from being abandoned.

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted



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